

REMARKS

Reconsideration of this application, based on this amendment and these following remarks, is respectfully requested.

Claims 3 through 10, 13, 15 through 18, and 26 through 30 remain in this case. Claims 8, 13, 15 through 17, 26, and 28 are amended. Claims 1, 2, 11, 12, 14, and 19 through 25 are canceled.

Claims 1 through 7, 11, 12, 15 through 17, 26, and 27 were rejected under §102(a) as anticipated by the Graham et al. reference.¹ Claims 19 through 24 were rejected under §103 as unpatentable over the Graham et al. reference in view of the Datar reference². Claim 18 was rejected under §103 as unpatentable over the Graham et al. reference in view of the Pua et al. reference³. Claim 25 was rejected under §103 as unpatentable over the Graham et al. reference in view of the Datar et al. and Pua et al. references, and claims 28 through 30 were rejected under §103 as unpatentable over the Graham et al. reference in view of the Watanabe reference⁴.

No rejection is presented in the Office Action to claims 8 through 10. Applicants thus presume that these claims are considered allowable. In addition, despite the statement that the previous finding of the allowability of claims 13 and 14 is withdrawn,⁵ no rejection is presented

¹ International Publication Number WO 01/78020 A1, published 18 October 2001. Upon further investigation of the Graham reference, however, Applicants have become aware of U.S. Patent No. 6,402,028 B1, issued June 11, 2002 to Graham, Jr., et al., based on a U.S. patent application filed on April 6, 1999. This U.S. Patent 6,402,028 appears to substantially correspond to, and is substantially cumulative to, Graham PCT reference applied against the claims. Accordingly, while Applicants will present argument relative to the Graham PCT reference applied against the claims because of the existence of the Graham, Jr. et al. U.S. Patent, Applicants do not admit that the Graham PCT reference is prior art against the claims in this case.

² U.S. Patent Publication No. 2002/0137501 A1, published September 26, 2002 from an application filed March 23, 2001.

³ U.S. Patent Publication No. 2002/0194403 A1, published December 19, 2002 from an application filed June 15, 2001.

⁴ U.S. Patent No. 6,148,366, issued November 14, 2000 to Watanabe, from an application filed November 24, 1997.

⁵ Office Action of June 15, 2005, page 2.

in the Office Action to claim 14. Applicants therefore also presume that claim 14 is also considered allowable.

To advance the prosecution of this case, claims 1, 2, 11, 12, and 19 through 25 are canceled, obviating the rejection to those claims. This cancellation is intended to be without prejudice to the presentation of those or similar claims in a continuing application from this case.

Claim 13 is amended to include the limitation of claim 14, and claim 14 is canceled accordingly. Because the Office Action presents no basis for the rejection of claim 14, Applicants submit that amended claim 13 is now in condition for allowance. In addition, claims 15 through 17 are amended to now depend on claim 13; Applicants therefore submit that claims 15 through 18⁶ are now also allowable.

Claim 8, noted as allowable above, is amended simply to correct an error in punctuation.

Applicants respectfully traverse the §102 rejection of claim 3 and its dependent claims.

In the new basis of rejection of claim 3, the Examiner asserts that the Graham et al. reference discloses the embedding of new firmware into a first command,⁷ and also discloses the extracting of the embedded new firmware from that first command at a reader.⁸ Applicants respectfully traverse the rejection on the grounds that the Graham et al. reference does not disclose such embedding or such extracting, either at the cited locations or anywhere else in the reference.

It is instructive to restate the cited portion of the Graham et al. reference applied against claim 3:

Also termed interface device (IFD), chip-accepting device (CAD), chip card reader (CCR), smart card adapter and card reader device, a terminal may be any

⁶ Claim 18 being dependent on claim 15.

⁷ Office Action of June 15, 2005, page 3 (relative to claim 2), *citing* Graham et al. *supra*, at page 38, line 27 through page 39, line 2.

⁸ *Id.*, *citing* Graham et al., *supra*, page 39, lines 1 and 2.

suitable interface device that functions to transfer information and commands between smart card and user and/or a computing device. A terminal may be a non-intelligent device that simply provides power to a card and facilitates the transfer of information, or may be as complex as a merchant terminal that includes a processor, application software, and the ability to communicate over a network.⁹

This cited portion of the Graham et al. reference makes no mention of the embedding or extracting of firmware within a command by a reader, as required by claim 3, nor is there even any implicit reference to such embedding or extracting of such firmware in this passage. To the extent that the rejection of claim 3 and its dependent claims is based on an interpretation of this passage of the Graham et al. reference that such embedding and extracting is disclosed, Applicants respectfully traverse the rejection.

Applicants further respectfully submit that the Graham et al. reference nowhere discloses these embedding and extracting steps of claim 3 and its dependent claims. For example, in the portion of the reference pertaining to the post-issuance loading of applications,¹⁰ which is the most pertinent portion of the reference to claim 3, there is no mention whatsoever of the embedding of new firmware in a command or its extracting. Indeed, the reference specifically describes the adding of these applications without reference to the terminal or reader.¹¹ The other portions of the reference, related to "smart card production", do not refer to any reader, but instead refer to a "card production system 216",¹² and as such add no teachings in this regard. Accordingly, Applicants respectfully submit that the Graham et al. reference fails to disclose or suggest the embedding and extracting steps of claim 3.

For these reasons, Applicants submit that claim 3 and each of its dependent claims are novel over the Graham et al. reference, properly interpreted.

Applicants further respectfully submit that there is no suggestion from the prior art to modify the teachings of the Graham et al. reference to provide the combination of the

⁹ Graham et al., *supra*, page 38, line 26 through page 39, line 2.

¹⁰ Graham et al., *supra*, page 34, line 16 through page 40, line 18.

¹¹ *Id.*, at page 39, lines 9 through 19.

¹² Graham et al., *supra*, page 19, lines 15 through 19.

embedding and extracting steps with the other steps of the method of claim 3. As mentioned above, the Graham et al. reference fails to disclose these steps. Applicants submit that none of the other references disclose these steps; indeed, the Examiner failed to cite any other reference teaching these steps. Nor is there any suggestion present in the prior art of record to so modify the teachings of the Graham et al. reference so as to meet claim 3 and its dependent claims.

For these reasons, Applicants submit that claim 3 and its dependent claims are not only novel, but are patentably distinct over the prior art of record in this case.

Claim 28 is amended to now depend on claim 3, rather than upon claim 1 (now canceled) upon which it previously depended. For the reasons discussed above relative to claim 3, Applicants respectfully submit that amended claim 28 and its dependent claims 29 and 30 are also novel and patentably distinct over the prior art of record in this case.

Claim 26 is amended to now also recite, as a capability included within those of the in-system programming capabilities of the firmware element, the capability of extracting embedded updated firmware code from the first command that is received by the firmware. This extracting capability corresponds to the extracting step of claim 3, discussed above, and as such its incorporation into claim 26 involves no new matter.

And for similar reasons as discussed above relative to claim 3, Applicants submit that claim 26 and its dependent claims are novel over the Graham et al. reference and the other prior art of record in this case. Specifically, neither the cited portion nor the remainder of the Graham et al. reference discloses the embedding of updated firmware code into a first command nor the extracting of that embedded updated firmware code from such a command. Accordingly, Applicants respectfully submit that amended claim 26 and its dependent claims are novel over the Graham et al. reference.

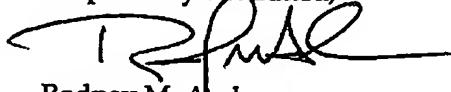
Applicants further respectfully submit that amended claim 26 and its dependent claims are patentably distinct over the prior art of record in this case. None of the other references of record disclose or suggest the embedding and extracting capabilities required of the firmware of the adapter of amended claim 26, nor is there any citation to the prior art in this regard in the

Office Action itself. Accordingly, Applicants respectfully submit that the combined teachings of the prior art of record in this case fall short of the requirements of amended claim 26 and its dependent claims. In addition, Applicants submit that there is no suggestion from the prior art to modify these teachings in such a manner as to reach the requirements of claim 26. For these reasons, Applicants submit that amended claim 26 and its dependent claims are not only novel but are patentably distinct over the prior art of record in this case.

For all of the above reasons, Applicants respectfully submit that all claims now in this case are in condition for allowance. Reconsideration of this application is therefore respectfully requested.

Please also ensure that the records of the Patent and Trademark Office properly refer to the undersigned as the correspondence address in this case, as indicated in the Power of Attorney and Change of Correspondence Address filed February 7, 2005 in this case.

Respectfully submitted,



Rodney M. Anderson

Registry No. 31,939

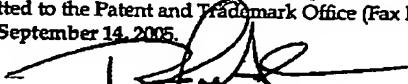
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37 C.F.R. 1.8

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